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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,032	10/21/2005	Joshua Robert Nemeth	WPTA125284	2210
26389 7590 02/05/2008 CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347				
			EXAMINER GRABOWSKI, KYLE ROBERT	
			ART UNIT 3722	PAPER NUMBER
			MAIL DATE 02/05/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/535,032	NEMETH, JOSHUA ROBERT	
	Examiner	Art Unit	
	KYLE GRABOWSKI	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,13,15,17-19,21,22,28,41-43 and 47-50 is/are pending in the application.
- 4a) Of the above claim(s) 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,13,15,17-19,21,22,41-43 and 47-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05/13/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/13/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of claims 1-8, 13, 15, 17-19, 21-22, 41-43, and 47-50, and Figures 6-7 in the reply filed on December 14, 2007 is acknowledged.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: It does not contain the duty to disclose information which is *material to patentability*.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6, 13, 15, 21, and 41-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Pekko (US 3,631,617).

In respect to claims 1-4, Pekko discloses: a transparent support layer 10, "which is at least transparent in areas where visual indicia are to be printed on the undersurface thereof" (Col. 2, Lns 51-52); security layers 14 and 22 which contain security regions supporting visual indicia 16 and 26, respectively, which are visible throughout the transparent layers forming a composite image (Fig. 1); the security layer 22 is "transparent where indicia 16 must be visible" (Col. 4, Lns 49-50, Fig 2); two tamper evident layers 12 and 20 are placed between the support layer 10 and security layers 14 and 22 - exposure to an attempt to delaminate the document results in "destroying the intelligence of the imprint [indicia]" (Abstract); Figure 2 shows the separated (and destroyed intelligence) of indicia 26 after delamination of security layer 22 from support layer 10 - it should be noted that the regions of the tamper evident layer destruct the indicia rather than self-destruction. In regards to application in a security document, Pekko discloses that "self-supporting film 10 may also be a laminate such as a paper print laminated to at least one or between two normally solid polymeric surfaces in a manner which provides a window through which the underprinted visual indicia 16 will appear" (Col. 3, Lns 2-6); tamper evident layers 12 and 20 have "limited or even essentially no adhesion to the self-supporting film 10" (Col. 2, Lns 53-54), therefore rendering them "weakly coherent" at least in terms of the support layer.

In respect to claims 6 and 15, Pekko further discloses: support layer 10 may be fabricated from "any material of sufficient integrity"...such as polycarbonate (Col. 2, Ln

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74) or polypropylene (Col. 2, Ln 71); outer layer 24, overlaying security layer 22, "may be identical, or different, from construction of the self-supporting film 10" (Col. 5, Lns 10-12).

In respect to claim 13, Pekko further discloses a different embodiment of the tamper evident layer wherein a "flame or corona treated polyethylene" is utilized; the "untreated portion provides in essence a fragile printing which serves as the mask surface [tamper evident layer] 12 and which will remain with all or part of the adhesive when film 10 is removed" (Col. 3, Lns 38-41).

In respect to claim 21, as discussed above in claims 1-4, Pekko discloses a composite image. The first part of the image resides on the upper "security region" of security layer 14 and the second part of the image resides on the lower "security region" of the security layer 22 (Fig. 1).

In respect to claims 41-43, Pekko inherently discloses applying a first tamper evident means 12 on one side of the transparent support layer 10, applying a second tamper evident means 20 on the opposite side of the transparent support layer 10, applying a first security layer 14 over the first tamper evident means 12, applying a second security layer 22 over the first tamper evident means 20, and applying a polymeric outer layer over at least one of the security layers; Pekko also discloses the other limitations for the reasons stated above.

Claim Rejections - 35 USC § 103

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 5, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pekko (US 3,631,617). Pekko substantially discloses the claimed subject matter for the reasons stated above including that the support layer 10 may be made of polycarbonate or polypropylene, and the outer layer 24 may be of identical construction to the support layer 10; Pekko also discloses that the tamper evident layer 12 may be composed of untreated polyethylene, however Pekko does not disclose a specific type of polypropylene or polyethylene making it impossible to ascertain the glass transition temperatures (which vary considerably with other different subgroups of the material).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to chose a variation of polyethylene that has a glass transition temperature lower than 30 degrees C than the polycarbonate or polypropylene support and outer layers, since it has been held to be within the general skill of a worker in the

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art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. A choice of low density polyethylene (-125 C) is drastically lower than atactic polyethylene (-20 C) or isotactic polyethylene (100C) (see Polymer Chemistry: Glass Transition) and is one example of an obvious material choice.

6. Claims 17-18, 22, and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pekko (US 3,631,617) in view of Schaefer et al. (US 4,557,505). Pekko substantially discloses the claimed subject matter for the reasons stated above but does not disclose an opacifying coating as tamper evident means within the tamper evident layer. Schaefer et al. disclose a stress-opacifying layer 11, which indicates tampering (Abstract, Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the tamper evident laminate taught in Pekko with a stress opacifying layer (either along with the tamper evident layers 12 or 20, or separate and adjacent to the layers provided as further tamper evident means, for example over the security regions underlying the indicia 16 and 26) to utilize further visual evidence of tampering.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pekko (US 3,631,617) in view of Schaefer et al. (US 4,557,505) as applied to claim 17 above, and further in view of Smits et al. (US 4,837,061). Pekko as modified by Schaefer et al. substantially disclose the claimed subject matter for the reasons stated above but do

not disclose a tamper evident device that changes color upon tampering. Smits et al. disclose a tamper evident structure with "irreversible color change" that may be "incorporated into a variety of closable articles or products to provide evidence of opening or tampering" (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the tamper evident laminate taught in Pekko as modified by Schaefer et al. with a color changing layer (again either along with the tamper evident layers 12 or 20, or separate and adjacent to the layers provided as further tamper evident means) to utilize further visual evidence of tampering.

8. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pekko (US 3,631,617) in view of Smits et al. (US 4,837,061). Pekko substantially discloses the claimed subject matter for the reasons stated above but does not disclose a tamper evident device that changes color upon tampering. Smits et al. disclose a tamper evident structure with "irreversible color change" that may be "incorporated into a variety of closable articles or products to provide evidence of opening or tampering" (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the tamper evident laminate taught in Pekko with a color changing layer (again either along with the tamper evident layers 12 or 20, or separate and adjacent to the layers provided as further tamper evident means) to utilize further visual evidence of tampering.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kay et al. (US 5,319,475), Wright et al. (US 6,416,857), Hoffer et al. (US 5,633,058), Decker (US 6,033,762), and Andric et al. (US 5,449,200) disclose similar inventions. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KYLE GRABOWSKI whose telephone number is (571)270-3518. The examiner can normally be reached on Monday-Thursday, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KG

Kyle Grabowski
Examiner, Art Unit 3722

Monica S. Carter
MONICA CARTER
SUPERVISORY PATENT EXAMINER